

Attorney's Docket No.:
2001P7463US

17

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed September 16, 2004. At the time of the Office Action, Claims 1-36 were pending and stand rejected. Applicant has amended Claims 1, 7, 13, 19-22, 27, and 32. Applicant submits that no new matter has been added by these amendments. In light of the arguments below, Applicant respectfully requests reconsideration and favorable action in this case.

Section 103 Rejections

The Examiner rejects under 35 U.S.C. § 103(a): Claims 1, 4, 7, 10-11, 13, and 16-17 as being unpatentable over Heinmiller et al. Publication No. WO 99/59353 ("*Heinmiller*") in view of Sayers et al. U.S. Patent No. 6,539,237 ("*Sayers*"); Claims 2, 8, and 14 as being unpatentable over *Heinmiller* and *Sayers* in view of Sienel et al. U.S. Patent No. 6,426,942 ("*Sienel*"); Claims 2, 8, and 14 as being unpatentable over *Heinmiller*, *Sayers* and *Sienel* in view of Baratz et al. U.S. Patent No. 5,742,596 ("*Baratz*"); Claim 5 as being unpatentable over *Heinmiller* and *Sayers* in view of Kimball U.S. Patent No. 5,953,322 ("*Kimball*"), Iwama et al. U.S. Patent No. 6,600,735 ("*Iwama*"), and *Sienel*; and Claims 6, 12, and 18 as being unpatentable over *Heinmiller* and *Sayers* in view of *Iwama*. Applicant respectfully traverses these rejections and assertions therein.

Applicant respectfully submits that the combination of *Heinmiller* and *Sayers* as proposed by the Examiner fails to disclose, teach, or suggest elements specifically recited in Applicant's claims. For example, the *Heinmiller-Sayers* combination proposed by the Examiner fails to disclose, teach, or suggest the following combination of elements specifically recited in independent Claim 1, as amended:

(1) a packet subsystem operable to "determine that the mobile station has registered with the wireless subsystem," and "instruct the telephone subsystem in response to determining that the mobile station has registered with the wireless subsystem";

(2) a telephone subsystem operable to "receive the instruction from the packet subsystem," and "in response to receiving the instruction, forward a telephone call directed at the telephonic device to the packet subsystem."

Heinmiller discloses a system and method for routing a call. According to *Heinmiller*:

Attorney's Docket No.:
2001P7463US

18

When the calling party 210 places a call to the called party, the first computer readable program code 250 automatically determines the availability of the called party's wireless communication unit 230 (step 310). In response to the called party's wireless communication unit 230 being determined unavailable, the second computer readable program code 260 automatically routes the call to the called party's landline communication unit 220 (step 320).

(*Heinmiller*, page 4, lines 1-8.) That is, *Heinmiller* discloses that *when a call is placed*, code determines whether a wireless communication unit is available, and routes the call to a landline communication unit if the wireless communication unit is unavailable.

According to *Heinmiller*, a service control point (SCP) may determine the availability of a wireless communication unit in the following manner:

First, SCP 460 sends a location request to the HLR 480 of the MSC 470 (step 610). ... Upon receiving the request, the HLR 480 determines the routing address of the wireless communication unit 420 and sends a response containing the routing address, if available, to the SCP 460 (step 620). ... If the response contains the routing address of the wireless communication unit 420 and does not indicate that the wireless communication unit 420 is inactive (e.g., if the "access denied" field is populated by any value except "2" (inactive)), the SCP 460 sends a forward call command to the SSP 430 (step 640), and the call is routed through the MSC 470 to the wireless communication unit 420 (step 570).

(*Heinmiller*, page 6, line 16–page 7, line 5.)

That is, *Heinmiller* discloses that a service control point (SCP) *sends a request* to determine the availability of a wireless communication unit *when a call is placed*. *Heinmiller*, however, fails to disclose, teach, or suggest performing any instruction *when a wireless communication unit registers*, or forwarding a call *in response to the instruction*. Thus, *Heinmiller* fails to disclose, teach, or suggest a packet subsystem operable to "determine that the mobile station has registered with the wireless subsystem," and "instruct the telephone subsystem in response to determining that the mobile station has registered with the wireless subsystem," or a telephone subsystem operable to "receive the instruction from the packet subsystem," and "in response to receiving the instruction, forward a telephone call directed at the telephonic device to the packet subsystem."

Thus, *Heinmiller* fails to disclose, teach, or suggest the combination of elements specifically recited in Claim 1, whether *Heinmiller* is considered alone or in combination with *Sayers*, *Sienel*, *Kimball*, or *Iwama*, as proposed by the Examiner. Accordingly, the *Heinmiller-Sayers* combination proposed by the Examiner fails to disclose, teach, or suggest

Attorney's Docket No.:
2001P7463US

19

the combination of elements specifically recited in independent Claim 1. For at least these reasons, Claim 1 is allowable over the references of the rejection.

The dependent claims are allowable based on their dependence on the independent claim and further because they recite numerous additional patentable distinctions over the references of the rejection. Because Applicant believes he has amply demonstrated the allowability of Claim 1 over the references of the rejection, and to avoid burdening the record, Applicant has not provided additional detailed remarks concerning these dependent claims. Applicant, however, remains ready to provide such remarks if it becomes appropriate to do so.

Independent Claims 7 and 13 recite certain elements similar to elements (1) and (2). Accordingly, for at least the same reasons, Applicant also respectfully requests reconsideration and allowance of independent Claims 7 and 13, together with their dependent claims.

The Examiner rejects under 35 U.S.C. § 103(a): Claims 19-22, 26-29, and 32-34 as being unpatentable over *Heinmiller* and *Sayers* in view of *Kimball* and *Iwama*; Claims 23, 30, and 35 as being unpatentable over *Heinmiller*, *Sayers*, *Kimball*, and *Iwama* in view of *Sienel*; and Claims 23, 30, and 35 as being unpatentable over *Heinmiller*, *Sayers*, *Kimball*, and *Iwama* in view of *Baratz*. Applicant respectfully traverses these rejections and assertions therein.

Independent Claims 19, 20, and 21 recite certain elements similar to elements (1) and (2). Accordingly, for at least the same reasons, Applicant also respectfully requests reconsideration and allowance of independent Claims 19, 20, and 21.

Applicant respectfully submits that the combination of *Heinmiller*, *Kimball*, and *Iwama* as proposed by the Examiner fails to disclose, teach, or suggest elements specifically recited in Applicant's claims. For example, the *Heinmiller-Kimball-Iwama* combination proposed by the Examiner fails to disclose, teach, or suggest elements (3) and (4) specifically recited in independent Claim 22, as amended:

(3) a gatekeeper operable to "register the client," and "instruct the telephone subsystem in response to registering the client"; and

(4) a telephone subsystem operable to "receive the instruction from the packet subsystem," and "in response to receiving the instruction, forward a first telephone call directed at the telephonic device to the gateway."

Attorney's Docket No.:
2001P7463US

20

As discussed above, *Heinmiller* discloses that a service control point (SCP) *sends a request* to determine the availability of a wireless communication unit *when a call is placed*. *Heinmiller*, however, fails to disclose, teach, or suggest providing any instruction *when a wireless communication unit registers*, or forwarding a call *in response to the instruction*. Thus, *Heinmiller* fails to disclose, teach, or suggest a gatekeeper operable to "register the client," and "instruct the telephone subsystem in response to registering the client," or a telephone subsystem operable to "receive the instruction from the packet subsystem," and "in response to receiving the instruction, forward a first telephone call directed at the telephonic device to the gateway."

Thus, *Heinmiller* fails to disclose, teach, or suggest the combination of elements specifically recited in Claim 22, whether *Heinmiller* is considered alone or in combination *Kimball, Iwama*, or *Baratz* as proposed by the Examiner. Accordingly, the *Heinmiller-Kimball-Iwama* combination proposed by the Examiner fails to disclose, teach, or suggest the combination of elements specifically recited in independent Claim 22. For at least these reasons, Claim 22 is allowable over the references of the rejection.

The dependent claims are allowable based on their dependence on the independent claim and further because they recite numerous additional patentable distinctions over the references of the rejection. Because Applicant believes he has amply demonstrated the allowability of Claim 22 over the references of the rejection, and to avoid burdening the record, Applicant has not provided additional detailed remarks concerning these dependent claims. Applicant, however, remains ready to provide such remarks if it becomes appropriate to do so.

Independent Claims 27 and 32 recite certain elements similar to elements (3) and (4). Accordingly, for at least the same reasons, Applicant also respectfully requests reconsideration and allowance of independent Claims 27 and 32, together with their dependent claims.

Attorney's Docket No.:
2001P7463US

21

CONCLUSION

For the foregoing reasons and for reasons clearly apparent, Applicant respectfully requests allowance of all pending claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicant stands ready to conduct such a conference at the convenience of the Examiner.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 19-2179 of Siemens Information & Communications Products, L.L.C.

Date: Dec. 15, 2004

CUSTOMER NUMBER 28524
SIEMENS CORPORATION
Intellectual Property Department
170 Wood Avenue South
Iselin, New Jersey 08830
ATTENTION: Elsa Keller, IP Department
Telephone: (732) 321-3026.

Respectfully requested,

By: Thomas George
Thomas George
Registration No. 45,740
Attorney for Applicants
Tel: 650-694-5191
Fax: 650-968-4517